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10/041,129	07/23/2003	Ram K. Ramesh	D-42941-02	7079

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EXAMINER

GERRITY, STEPHEN FRANCIS

ART UNIT PAPER NUMBER

3721

DATE MAILED: 10/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/041,129

Applicant(s)

RAMESH ET AL.

Examiner

Stephen F. Gerrity

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3721

3DETAILED ACTION

Drawings

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because new proposed figure 5, filed 29 July 2004, is informal in quality -- a formal version of figure 5 is now required. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Specification

2. The amendment to the specification, filed 29 July 2004, has been entered.

Claim Objections

3. Claims 45 and 46 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 44 recites the limitation that "the first layer, consists essentially of at least one member

Art Unit: 3721

selected from the group consisting of ..." and then lists a number of different polymers. Claim 45 recites the limitation that "the first layer consists essentially of at least one member selected from the group comprising ..." and then lists a number of different polymers. It is noted that the polymers listed in claim 45 are not included in the list of polymers recited in claim 44. Likewise, claim 46 does not recite any of the polymers listed in claim 45 or claim 46.

Accordingly, each of claims 45 and 46 fails to further limit the claim from which it depends. It is conceivable that claim 45 or claim 46 could be infringed without infringing claim 44 or claim 45, respectively.

Finally, in claim 46, the language "at least one member selected from the group consisting of homogeneous ethylene/alpha-olefin copolymer" is considered to be awkward because there is only one member in the listed group.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 44-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point

Art Unit: 3721

out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 recites that the first layer comprises polyolefin. Claim 44 recites the limitation that "the first layer, consists essentially of at least one member selected from the group consisting of ..." and then lists a number of different polymers, but the list does not include polyolefin. This renders the claim vague and indefinite because it is unclear from applicant's claim language if the subject matter of claim 44 is intended to exclude the polyolefin recited in claim 22 or to be in addition to the polyolefin recited in claim 22. Clarification and correction by way of amendment to claim 44 is requested.

Claims 45 and 46 are likewise vague and indefinite because it is unclear if the subject matter of these claims is intended to be excluding previous subject matter or in addition to the previous subject matter.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior

Art Unit: 3721

art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 22-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art (**AAPA**) in view of Bauer et al. (**US 5,837,358**).

AAPA (see page 2, lines 5-15 of applicant's specification) teaches that the method of placing a first product in a flexible bag formed from heat-shrinkable film, placing a second product in a flexible bag formed from heat-shrinkable film, stacking one bag on top of the other, and heat-sealing the first bag and second bag is old and well known in the prior art. AAPA meets all of the claimed subject matter with the exception of the composition of the bag, that is, the particular layers of the bag.

The Bauer et al. reference discloses a bag (see col. 15, lines 44-50 and col. 16, lines 52-54) used in a similar process (see col. 1, lines 10-20, col. 4, lines 4, lines 22-25, and col. 15, lines 44-50) which meets the claimed structure of the bag, that is, a first layer of polyolefin (col. 13, lines 22-24) which is the inside layer (14), a second layer of polyolefin (col. 14, lines 9-11) which is the interior layer (17), a third layer of polyester (col. 14, lines 25-29) which is the interior

Art Unit: 3721

layer (18), and a fourth layer of polyester (col. 13, lines 38-40) which is the outside layer (15) -- as seen in figure 2.

It would have been obvious to a person having ordinary skill in the art, at the time applicant's invention was made, to have modified the method set forth in AAPA by having substituted the bag structure disclosed in Bauer et al. for the bag disclosed in AAPA, because the substitution of one old and well known bag structure for another old and well known bag structure is routine in the art, where as here there is presently no evidence that would reasonable convey that some result would be achieved by modification of the old and well known method set forth in AAPA that would be unexpected or contradict the expected result of AAPA. The structure of the bag does not effect the modified method in a manipulative sense.

Regarding the polyester of the third layer having a melting point of from about 130°C to about 260°C in claim 22, and the other composition limitations in the claims, the now modified AAPA does not disclose these limitations. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have employed a polyester as the third layer having a melting point of from about 130°C to about 260°C, since it has been held that discovering an optimum value

Art Unit: 3721

of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272; 205 USPQ 215 (CCPA 1980). Additionally, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Also, the selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

Regarding new claim 44, the Bauer et al. reference teaches the use of polyester (col. 13, line 24) as a first layer, and as set forth above the subject matter of the claim is likewise considered unpatentable.

Regarding new claim 45, the Bauer et al. reference teaches the use of ethylene/alpha-olefin copolymer (col. 13, lines 29 and 30) as a first layer, and as set forth above the subject matter of the claim is likewise considered unpatentable.

Note that for both claims 44 and 45, the language of the claim includes the quasi-open terminology "consists essentially of ..." and thus these claims do not exclude other non-recited polymers, etc.

Art Unit: 3721

Response to Arguments

8. Applicant's arguments, see pages 8-10, filed 24 September 2004, with respect to the objection to the drawings and specification have been fully considered and are persuasive. The objections to the drawings and specification have been withdrawn.

9. Applicant's arguments filed 24 September 2004 have been fully considered but they are not persuasive.

Applicant at page 10 of the response argues that the examiner has not identified the specific portion of the Bauer et al. reference relied upon for the teaching of "a bag used in a similar process which meets [Applicant's] claimed structure of the bag". Applicant states that applicants have reviewed the Bauer et al. reference in an effort to locate a teaching of a bag which meets applicant's claimed structure. While the previous Office action did not recite the portion of the Bauer et al. reference relied on, the present Office action points to the different figures, columns and lines where the Bauer et al. does in fact specifically point out the structure of a bag used in a similar process which meets the claimed structure of the bag. The rejection made in the previous Office action is not

Art Unit: 3721

considered to be in error for the fact that the columns, lines, and/or figures were not specifically pointed out.

Applicant states, paragraph bridging pages 10 and 11, that none of the examples in Bauer et al. discloses a film having applicant's recited third layer which comprises polyester, not to mention the combination of applicant's recited third layer in combination with applicant's fourth layer, and that none of the films in the examples of Bauer et al. have any interior layer comprising polyester. Applicant then admits the Bauer et al. reference discloses that one or more of a wide variety of polymers can be present in various multilayer film constructions. Applicant then sets forth various passages from the Bauer et al. reference, at pages 11 and 12 of the response, and then at page 12 states that Bauer et al. lists a very wide variety of polymers for the first, second, third, and fifth layers of the film, and states that polyester is not in any one or more of the listings of preferred polymers for any one or more of the first, second, third and fifth layers. The applicant then admits that when using hindsight based on applicant's teaching it is in fact possible to construct a film which meets the features of the film recited in the claim. The examiner points out that this is not a question of hindsight or

Art Unit: 3721

one of picking and choosing. Rather it is a question of fact, i.e. are the recited elements found in the prior art reference applied. The mere fact that the reference may recite a wide variety of polymers and may not recite polyester as a preferred polymer is not at issue, and is not material to the question of whether or not the examiner has used hindsight to pick and choose from the recited polymers in the reference. Rather a review of the reference shows that a bag which meets the claimed structure is disclosed in the Bauer et al. reference. The following, taken from MPEP section 2131.02, supports the examiner's position and view:

A REFERENCE THAT CLEARLY NAMES THE CLAIMED SPECIES ANTICIPATES THE CLAIM NO MATTER HOW MANY OTHER SPECIES ARE NAMED

A genus does not always anticipate a claim to a species within the genus. However, when the species is clearly named, the species claim is anticipated no matter how many other species are additionally named. Ex parte A, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990) (The claimed compound was named in a reference which also disclosed 45 other compounds. The Board held that the comprehensiveness of the listing did not negate the fact that the compound claimed was specifically taught. The Board compared the facts to the situation in which the compound was found in the Merck Index, saying that "the tenth edition of the Merck Index lists ten thousand compounds. In our view, each and every one of those compounds is described' as that term is used in 35 U.S.C. § 102(a), in that publication."). Id. at 1718. See also In re Sivaramakrishnan, 673 F.2d 1383, 213 USPQ 441 (CCPA 1982) (The claims were directed to polycarbonate containing cadmium laurate as an additive. The court upheld the Board's finding that a reference

Art Unit: 3721

specifically naming cadmium laurate as an additive amongst a list of many suitable salts in polycarbonate resin anticipated the claims. The applicant had argued that cadmium laurate was only disclosed as representative of the salts and was expected to have the same properties as the other salts listed while, as shown in the application, cadmium laurate had unexpected properties. The court held that it did not matter that the salt was not disclosed as being preferred, the reference still anticipated the claims and because the claim was anticipated, the unexpected properties were immaterial.).

Accordingly, as the structure of the bag is disclosed in the Bauer et al. reference that meets the limitations of the claim there is no question or issue that the examiner has made use of hindsight based on applicant's specification to arrive at applicant's claimed invention from AAPA in view of Bauer et al. Further, the question of whether the Bauer et al. reference meets the language in question is not at issue based on the decisions cited in the above quoted section of the MPEP.

Applicant also argues a second point regarding the 35 U.S.C. 103(a) rejection set forth in the prior Office action and repeated herein. That is, there is no teaching or suggestion in the prior art to use the film in the stack sealing process recited in applicant's claims. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to

Art Unit: 3721

produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the prior art (AAPA and Bauer et al.) teaches the claimed invention, and the Bauer et al. reference teaches why the film structure is especially suited for heat-shrinking bags for the packaging of meat products. Furthermore, the bag structure recited in the claims does not effect the manipulative steps of the claims beyond it being provided. Since, the bag structure is known in the prior art as evidenced by Bauer et al., and Bauer et al. discloses and teaches why one would use the bag in a heat-shrinkable bag process, it is quite evident that there is sufficient motivation and suggestion to combine the prior art (AAPA and Bauer et al.) to have arrived at the claimed invention.

Regarding applicant's argument regarding new claims 44-46, In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "excludes

Art Unit: 3721

anhydride functional polymer") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The language "consisting essentially of" as noted from the MPEP section 2111.03 entitled "Transitional Phrases" instructs that:

[the] transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. In *re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original). ...

For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising."

In this instance, the applicants may argue that the claim language excludes certain features of the prior art, but applicant's written description does no such thing.

Finally, it is noted that applicant has not argued separately the dependent claims 23-43 nor has applicant challenged the examiner's position that it would have been obvious to substitute the old and well known bag of Bauer et al. for the old and well known bag of AAPA. Additionally, applicant has not argued or challenged the examiner's various statements

Art Unit: 3721

regarding the obviousness of the "melting point" language found in claim 22 or the other composition limitations found in the dependent claims as set forth in the previous Office action.

Conclusion

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

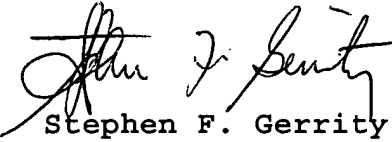
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gerrity. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, may be contacted. Any inquiry of a general nature or relating to the

Art Unit: 3721

status of this application or proceeding should be directed to the TC 3700 receptionist.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Stephen F. Gerrity
Primary Examiner
Art Unit 3721

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21 October 2004